

REMARKS

Reconsideration of the previous rejection of claims 14, 15 and 17-23 under 35 U.S.C. §103(a) as being unpatentable over Parasin (U.S. Patent 5,165,816) in view of Finkell (U.S. Patent 5,797,237) is respectfully requested.

Although the Examiner repeats the language of the claims as purported teachings of Parasin, there is clearly no disclosure in Parasin for such features. For example, the Examiner states that “Parasin discloses . . . a first equalizing cavity (upper 46) located adjacent to an upper end of a proximal end (24) of the tongue below the upper surface; wherein a distal end (16) of the tongue is smaller than a proximal end (32); a second equalizing cavity (bottom 42) formed by a gap between the proximal end 32 of the groove and the distal end of the tongue and further comprising glue (column 3, lines 15-20) disposed in at least one of the first equalizing cavity and the second equalizing cavity.” None of such limitations are found in the Parasin reference. To the contrary, the distal end of the tongue 18 is purposely made longer than the groove so as to contact the proximal end of the groove. See, particularly, column 3, lines 28-32. By contrast, the claimed invention has a gap between the proximal end of the groove and the distal end of the tongue forming a gap there between as clearly recited in the claims, e.g., See, each of independent claims 14, 15 and 17.

Thus, the claimed limitations are nowhere found in Parasin even though the Examiner paraphrases the claims and alleges such claim limitations as being attributable to the teachings of Parasin.

Applicants also note that the Examiner recognizes that Parasin does not disclose that the upper surfaces abut.

The proposed combination with Finkell is clearly without any motivation that would impel one skilled in the art to do what the Examiner suggests. As noted hereinabove, Parasin expressly teaches that his tongue is longer than the groove by the language “tongue 12 is preferably longer than groove 14 is deep such that once tongue tip 18 engages groove base 34” Column 3, lines 28-32 and Fig. 2. Thus, one skilled in the art, faced with the claim limitations, must either disregard this teaching of Parasin and, hence, the resulting spaces 46 (Fig. 2) which are formed as a result of such relationship by reducing the tongue length so as to bring panels 10 and 11 of Parasin closer together until they abut, also thereby eliminating spaces 46 in Parasin. Such a proposal is an anathema to the teachings of Parasin in an attempt to duplicate the claimed invention and contrary the relevant teachings of the references. For the foregoing reasons, the proposed combination of Parasin and Finkell cannot possibly establish a *prima facie* case of obviousness for claims 14, 15 and 17 (and claims dependent thereon).

Furthermore, each of independent claims 18 and 23 provide further limitations not found, nor taught, in either Parasin or Finkell nor made obvious by the proposed combination. For example, in independent claim 18, applicant states that in addition to the gap between the first board and the second board, there is also “a hole, in fluid communication with said gap, said hole having an opening below said groove.” This is clearly shown in applicant’s original drawings (e.g., Figs. 7 and 8) in which hole 7, being in fluid communication with gap 4’, has an opening below the groove as shown in the drawings. The proposed combination of Parasin and Finkell cannot teach or suggest such a limitation.

Furthermore, independent claim 23 specifies that upon mating the groove of the first board with the tongue of the second board, the glue is directed away from the upper surface and toward the lower surface of the boards. This is clearly not shown by Parasin and, to the contrary, upper channel 46

would clearly direct glue disposed between the boards upwardly through gap 46, being the exact opposite of the claimed invention. As noted above, the heretofore proposed combination of Parasin with Finkell would not have been obvious from the teachings of the references because, by eliminating the contact of a distal end of the tongue with the proximal end of the groove in Parasin, thereby also eliminates space 46. However, even in such a case, space 46 at both the upper and lower surfaces would be eliminated and, hence, there is no directing of the glue away from the upper surface and toward the lower surface of the boards as specified in independent claim 23. Accordingly, no possible proposed combination of Parasin and Finkell can establish a *prima facie* case of obviousness for the claimed invention of independent claims 18 and 23 (and claims dependent thereon). Accordingly, withdrawal of all the prior art rejections are respectfully requested.

Applicants note the Examiner's objection to the Amendment filed July 28, 2005, allegedly as introducing new matter into the disclosure, however, reconsideration of those rejections are requested.

As clearly specified in the original drawings, e.g., Figs. 7 and 8, there is shown a hole (7) "having an opening below said groove." While the Examiner would like to redefine applicant's language to state "hole (7) with an opening below only a solid non-groove portion of the board," is suggested, such alternative language would elevate the Examiner to the lexicographer of the patent application, rather than that such being left to applicants. As stated in *In re Borkowski*, 164 USPQ 642, 645 (CCPA 1970), wherein the Court stated:

"The Examiner's approach to determining whether appellant's claims satisfy the requirements of Section 112, appears to have been to study appellant's disclosure, to formulate a conclusion as to what he (the Examiner) regards as the broadest invention supported by the disclosure, and then to determine whether appellant's claims are broader than the Examiner's conception of what 'the invention' is. We cannot agree that Section 112 permits of such an approach to claims."

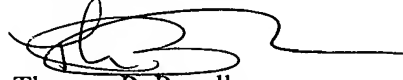
Thus is clear that the CCPA (whose decisions are binding on the Federal Circuit), long ago determined that it is the applicant (not the Examiner) who should draft the language to describe the invention. Applicant's Figs. 7 and 8 clearly show hole 7 having an opening "below said groove." Whether the Examiner takes issue as to whether the opening is "directly below" or "below the lowest level of a plane running coordinate with the lower surface of the groove" or "below only a solid non-groove portion of the board" or, alternatively, other words to describe the invention depicted in Figs. 7 and 8 is simply inappropriate. The choice of such language is not left to the discretion of the Examiner but, rather, to that of applicants and applicants have chosen language that describes Figs. 7 and 8. As Figs. 7 and 8 are part of the original disclosure, amendment of the specification to describe the figures does not introduce new matter into the specification. Accordingly, withdrawal of the objection to the Amendment filed July 28, 2005, is respectfully requested.

Lastly, applicants appreciate that the drawings filed July 28, 2005, have been accepted for purposes of examination.

However, applicants do not understand the Examiner's objection to the drawings under 37 C.F.R. §1.83(a). As shown in the marked-up Figs. 2, 4, 6, 7 and 8 of the drawings submitted on July 28, 2005, each of these drawings already has shown a gap between the distal end of the tongue and the proximal end of the groove and further amendment of these drawings to further specify the gap is redundant. Accordingly, withdrawal of the objection to the drawings are respectfully requested.

Having fully responded to the Examiner's grounds of objection and rejection, withdrawal of all objections and rejections are respectfully requested and passage of the application to issue is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas P. Pavelko', with a long horizontal line extending to the right.

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Date: January 19, 2006